

REMARKS

Claims 56-71, 95, 96 and 101 are pending in the application. The Applicants appreciate the Examiner's withdrawal of the Restriction Requirement with regard to examining the claims of Group II along with the elected claims of Group III. The Applicants are also pleased that the Examiner has indicated that claims 57-64, 66, 67, 69-71 and 96 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, 2nd paragraph.

Support in the Specification

The Applicants have amended claims 56, 95 and 101 to delete the reference to an oxo substituent (=O) on the carbon atom at position 2 of Formula VI, and to delete the references to an oxo and an amino (-NH₂) substituent on the carbon atom at position 4 of Formula VI. Since Applicants now claim less than that which was disclosed in the as-filed specification, no new matter has been added by this amendment.

Claims 58-60 and 62-64 have been amended to clarify that R₁ and R₂ of claim 56 are unbranched C₈, C₁₀, or C₁₂ alkyl groups. This amendment presents no new matter since claim 56, the claim from which claims 58-60 and 62-64 depend, clearly indicates that R₁ and R₂ are alkyl groups.

Claim 65 has been amended by replacing "NCO" with "NHCO" in the definition of "X". This amendment presents no new matter since claim 56, the claim from which claim 65 depends, recites that "X" is "selected from the group consisting of NHCO..." among other possibilities. Support for this amendment is also present in the specification at page 4, lines 18-20.

Also, the Applicants have amended the specification of the above-referenced application to recite the Examiner's suggested references to related applications to which the benefit of priority is claimed. The Applicants note that a PCT application cannot, of course, truly be a "continuation" or a "continuation-in-part" of a U.S. patent application. However, the Applicants consider that the Examiner's suggested language adequately conveys that the PCT application and the present application are entitled to priority to the two corresponding U.S. applications.

Thus, no new matter has been introduced by way of any of the amendments contained herein.

Correction of Filing Date

The Applicants have included along with this Amendment a copy of a "Petition for Corrected Filing Date" for the purpose of correcting the filing date of this Application to reflect the true filing date of October 4, 1999. This Petition is being simultaneously filed to Box DAC, in accord with MPEP § 1002.02(b).

Supplemental Information Disclosure Statement

The Applicants have submitted, as requested by the Examiner, a legible copy of each of the publications requested by the Examiner in the last Office Action, in the accompanying Supplemental Information Disclosure Statement. The Applicants note that one of the references requested by the Examiner (Kuman et al., Chemical Abstract 117CA 124476, 1992) is apparently erroneous, since this reference has the same citation as Scolaro et al., "Chemical Abstract", 117CA 124476, (1992).

Supplemental Declaration

Accompanying the present Amendment is a copy of a Supplemental Declaration (unexecuted), in accord with CFR 1.67(a). This Supplemental Declaration is being filed to satisfy the Examiner's objection to the Oath/declaration as being defective for failing to identify the proper filing date of Application No. 08/793,470 as May 2, 1997. The corresponding executed original Supplemental Declaration will follow shortly.

Rejection of Claims 56, 65, 68, 95 and 101 pursuant to 35 U.S.C. § 112, 2nd Paragraph

The Examiner has rejected claims 56, 65, 68, 95 and 101 pursuant to 35 U.S.C. § 112, 2nd paragraph. In item 6a, the Examiner indicates that in claims 56, 95 and 101, the compounds of Formula III contain an oxygen atom which is depicted as having a negative charge without a balancing positive counter-ion. The Applicants respectfully remind the Examiner that there is no requirement that only charge-neutral compounds be claimed. Indeed, the Applicants are claiming (as they are permitted to claim) an ionic species, as well as a pharmaceutical salt

thereof (see final lines of claims 56 and 101). Thus, these claims include the recited compound in its ionized form (e.g., in a solution) and in the form of a pharmaceutical salt (e.g., in a solid pharmaceutical dosage form). The Applicants therefore respectfully submit that the Examiner's rejection was in error, and should be withdrawn.

In item 6b, the Examiner indicates that each of claims 56, 95 and 101 contain an error with regard to the potential substituents on the carbon atom at the 2 position of the purinyl moiety of Formula VI. Claims 56, 95 and 101 no longer recite that an oxo substituent can be present at position 2 of Formula VI.

In item 6c, the Examiner indicates that in claims 56, 95 and 101, it is chemically impossible for the carbon atom at the 4 position of the purinyl moiety of Formula VI to have more than four covalent bonds, such as when an amine or oxo moiety is present as a substituent at position 4. Claims 56, 95 and 101 no longer recite that an amine or oxo substituent can be present at position 4 of Formula VI.

In item 6d, the Examiner indicates that in claims 56, 95 and 101, the pyrimidinyl moiety of Formula VII contains a nitrogen atom at the 3 position in the ring which is shown as only possessing two covalent bonds. The Examiner argues that it is unclear what else is covalently attached to this nitrogen atom. The Applicants respectfully submit that the ordinarily skilled artisan would understand that where a substituent is not indicated on an atom which is a member of a ring and which has the capacity for an additional covalent bond, a hydrogen atom would normally be present on that atom. Therefore, the ordinarily skilled artisan would know that Formula VII includes a hydrogen atom attached to the nitrogen atom at the 3 position. Thus, no amendment to Formula VII is necessary.

Thus, the Applicants respectfully submit that the Examiner's rejection of claims 56, 95 and 101 pursuant to 35 U.S.C. § 112, 2nd paragraph should be withdrawn.

In Item 6e, the Examiner indicates that in claim 65, there is insufficient antecedent basis for the recited element "NCO" in the definition of "X". The Applicants have amended claim 65 by replacing "NCO" with "NHCO". The Applicants respectfully submit that this amendment obviates this rejection, and that the rejection of claim 65 should be withdrawn.

In item 6f, the Examiner argues that the limitation "cytosine, guanine, xanthine and hypoxanthine" in the definition of "B" in claim 68 lacks a sufficient antecedent basis. The Applicants respectfully submit that there is sufficient antecedent basis for this limitation, since

claim 56, the claim from which claim 68 depends, recites that "B" can be either a purinyl moiety or a pyrimidinyl moiety having Formula VI or Formula VII, respectively, with various substituents as recited in the claim. Thus, it would be apparent to the ordinarily skilled artisan that cytosine, guanine, xanthine and hypoxanthine are within the scope of "B", as recited in claim 56. Thus, the Applicants respectfully submit that the Examiner's rejection was in error, and should be withdrawn.

Objection to Claims 58-60 and 62-64 for Informalities

In item 7 of the Office Action, the Examiner has objected to claims 58-60 and 62-64 on the basis of informalities. In particular, the Examiner argues that the claims fail to describe what is meant by C₈, C₁₀ and C₁₂ each for R₁ and R₂. The Applicants have amended claims 58-60 and 62-64 to clarify that C₈, C₁₀ and C₁₂ for each of R₁ and R₂ represent alkyl groups. The Applicants suggest that this amendment alleviates the informality, and that the Examiner's objection should be withdrawn.

Conclusion

The Applicants respectfully submit that each rejection and objection of the Examiner to the claims of the present application is inapplicable or should be withdrawn, and that each of claims 56-71, 95, 96 and 101 are in condition for allowance. Reconsideration and withdrawal of each of the rejections and objections, and the earliest possible allowance of each of these claims, are respectfully requested.

Respectfully submitted,

LOUIS S. KUCERA ET AL.

August 21, 2000 By: Kathryn Doyle
(Date) **KATHRYN DOYLE, Ph.D., J.D.**
Registration No. 36,317
AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.
One Commerce Square
2005 Market Street - 22nd Floor
Philadelphia, PA 19103-7086
Telephone: (215) 965-1200
Direct Dial: (215) 965-1284
Facsimile: (215) 965-1210
E-Mail: kdoyle@akingump.com

KD/RAA/moh

Enclosures: Copy of Petition for Corrected Filing Date w/ enclosures noted on Petition
Supplemental Declaration
Petition for One Month Extension of Time
Supplemental IDS and References (6)

75212v1